

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JUN 10 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAULINA P. GARCIA, JOHN W. LEE,
JOHN L. MARSHALL, DONALD A. MCGOWAN,
ANTHONY J. PUTTICK, THOMAS K. SPENCER, STEPHEN G. STROUD,
STEPHEN J. TELFER and MICHAEL J. ZURAW

Appeal No. 1998-0896
Application 08/479,077

ON BRIEF

Before GARRIS, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner because the record of this appeal is unclear with respect to the position of the examiner on each of the grounds of rejection forwarded in the examiner's answer of September 11, 1997 (Paper No. 11) that were of record in the final rejection of January 7, 1997 (Paper No. 7), and thus does not provide a basis for a reasoned decision on appeal. 37 CFR § 1.196(a) (1997); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., August 2001; 1200-29 – 1200-30; 6th ed., Rev. 3, July 1997; 1200-26).

The examiner states that each of the grounds of rejection under 35 U.S.C. §§ 112, second paragraph, and 103(a), respectively, "stands for the reasons of record and the following," and

then appears to merely address arguments raised by appellants apparently in response to the first action on the merits (answer, pages 3-5). Thereafter, the examiner addresses arguments that appellants submit in the brief (answer, pages 6-11).

It is the function of the examiner's answer to present in a single document the examiner's statement of the ground of rejection and the arguments and evidence on which the examiner relies in support thereof, for review on appeal. Indeed, we will not cull the examiner's arguments and evidence in support of the ground of rejection from the "record."

Accordingly, we remand this application to the examiner in order that the examiner shall take appropriate action consistent with current examining practice and procedure to state the grounds of rejection and supporting arguments and evidence in a supplemental examiner's answer, and to provide appellants with the opportunity to respond to the supplemental examiner's answer, with a view toward placing this application in condition for a reasoned decision on appeal with respect to the issues presented.


We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., August 2001; 700-105). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP § 1211 (8th ed., August 2001; 1200-30).

Remanded

Bradley B Harris

BRADLEY R. GARRIS
Administrative Patent Judge


CHARLES F. WARREN

CHARLES F. WARREN
Administrative Patent Judge

THOMAS A. WALTZ

THOMAS A. WALTZ
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 1998-0896
Application 08/479,077

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